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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91195327
Party	Plaintiff Hard Candy Cases, LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No.	:	77/700,559
For the Mark	:	Hard Candy
Filed	:	March 27, 2009
Published in the Trademark Official Gazette on	:	February 16, 2010

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HardCandy Cases, LLC	:	
Opposer,	:	Opposition No. 91195327
v.	:	
Hard Candy, LLC	:	Response to Applicant's Motion to Dismiss
Applicant.	:	

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Commissioner for Trademarks
P.O. Box 1451
Arlington, VA 22313-1451

RESPONSE TO APPLICANT'S MOTION TO DISMISS

HardCandy Cases, LLC (hereinafter "HCC" or "Opposer"), located and doing business in Danville, California, by and through its undersigned counsel hereby opposes the motion to dismiss filed by Hard Candy, LLC (hereinafter "Hard Candy" or "Applicant").

I. INTRODUCTION

First, Opposer notes that the present motion made by Applicant is related only to Opposer's second ground for opposition and no objection is made relative to Opposer's first ground for opposition.

Second, Opposer notes that Applicant cites multiple registered trademark applications owned by Applicant that are related to Applicant's current product lines of cosmetics, but notes with particularity that none of the cited registrations are within and/or related to goods or services within International Class 9. Therefore, the recitation and existence of such marks are irrelevant to the present motion.

Third, Applicant states that Opposer "baldly alleges" that Applicant did not have a bona fide Intent-to-Use the HARDCANDY mark at the time of filing. However, Applicant fails to acknowledge or recognize its own record over the past 15 years of repeatedly filing and subsequently abandoning over 100 trademark applications. Applicant also fails to mention Applicant's demonstrated pattern and practice, as highlighted in Opposer's Notice of Opposition, of systematically filing Intent-to-Use applications across multiple classes of goods and services ranging from "Furniture" to "Cheese flavored snacks," in an effort to stifle commerce.

Finally, much like Applicant's history with its multiple filings of Intent-to-Use applications, after making many accusations regarding Opposer's claims, Applicant simply abandon's its argument and makes a simple conclusory allegation that "the law is clear" in making its accusation regarding Opposer's second ground for opposition.

II. ARGUMENT

A. The Standard of Review in a Motion Dismiss Requires that All Facts at Issue be Resolved in the Favor of Opposer

A motion to dismiss for failure to state a claim under Fed. R. Civ. P. 12(b)(6), functions to test the legal adequacy of a complaint; it is a vehicle by which courts may evaluate pure legal questions. In other words, a motion to dismiss argues that the "harm" of which the plaintiff complains is not recognized as a violation of legal rights. For the purposes of a 12(b)(6) motion-to ensure that they focus only on matters of law-courts accept as true all reasonable allegations of fact in the complaint. Sutton v. Utah State School for the Deaf and Blind, 173 F.3d 1226, 1236 (10th Cir. 1999).

B. Madonna's "Hard Candy" Album is Entitled to Superior Protection Over Hard Candy's Naked Intent-to-Use Trademark Application

Applicant recites a litany of cases that stand for the proposition that, as a general premise, the titles associated with "single works" are not entitled to Federal trademark registration. However, Applicant fails to recognize two fundamental flaws in its recitation of these multiple cases.

First, the statement that titles of "single works" are not entitled to Federal trademark registration is a general proposition and not an absolute bar to registerability. Specifically, upon a showing of acquired secondary meaning, titles of "single works" can be registered. Secondary meaning, required for descriptive term to be protected as valid trademark, can be established in many ways, including, but not limited to, direct consumer testimony; survey evidence; exclusivity, manner, and length of use of a mark;

amount and manner of advertising; amount of sales and number of customers; established place in the market; and proof of intentional copying by defendant. Filipino Yellow Pages, Inc. v. Asian Journal Publications, Inc., 198 F.3d 1143 (9th Cir. 1999).

Second, Applicant's recitation of case citation related to registerability and arguments that registerability and superior rights are synonymous demonstrate a fundamentally flawed understanding of the interrelation of registration and superior rights. Federal registration is not required in order to establish superior rights. Educational Development Corp. v. Economy Co., 562 F.2d 26 (10th Cir. 1977). That is, rights under the Lanham Act and Superior Rights are not solely available through Federal registration of a mark. Specifically, the 10th Circuit has expressly held that even though trademark may not be validly registered under Lanham Trade-Mark Act because it is merely descriptive, common-law will afford protection similar to that under the Act if mark through usage has become, to purchasing public, associated with particular manufacturer or producer. Id.

Finally, whether the question is 1) has Madonna's Hard Candy mark acquired a secondary meaning or 2) whether Madonna's Hard Candy mark has superior rights to Applicant's HARDCANDY mark, both are questions of fact which, under the appropriate standard for review for a motion to dismiss, must be resolved in the favor of the non-moving party.

C. While Allegations of Fraud Must Be Pleaded with Particularity, Pleadings do NOT Need to be Accompanied by Some Element of Willfulness or Bad Faith, as Incorrectly Stated by Applicant.

Applicant begins by correctly asserting that Federal Rule of Civil Procedure 9(b) requires that allegations of fraud must be pleaded with particularity. However, Applicant

goes on to inappropriately conflate the evidentiary standard for fraud and the pleading standard for fraud and incorrectly asserts that "the alleged fraudulent misconduct 'must be accompanied by some element of willfulness or bad faith with must be established by clear, unequivocal and convincing evidence." International House of Pancakes, Inc. v. Elca Corp., 216 USPQ 521, 524 (TTAB 1982). While the standard recited in the International House of Pancakes v. Elca Corp. case is the appropriate standard of proof in a fraud matter, such an evidentiary standard *is not* appropriate in evaluation of a pleading. To hold otherwise would require that all evidence of fraud would necessarily need to be pleaded in the initial pleading. Opposer has appropriately pleaded each of the elements of fraud with sufficient particularity under the standard of Federal Rule of Civil Procedure 9(b).

III. PRAYER FOR RELIEF

Wherefore, Opposer respectfully requests that Applicant's motion to dismiss Opposer's Second Ground for Opposition be denied. In the alternative, if this tribunal finds Opposer's pleading deficient, Opposer respectfully requests that Opposer be allowed to amend its pleading.

Respectfully Submitted,

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on: August 16, 2010.

By: Dawn Calleiros

Dated: Aug. 16, 2010